REMARKS

Claims 1 to 66 were pending in the application at the time of examination. Claim 1 stands provisionally rejected under 35 U.S.C. §101 for double patenting. Claims 1, 17, 34 and 50 stand provisionally rejected for obviousness type double patenting. Claims 1, 2, 5, 9, 17 to 19, 22, 26, 34, 35, 38, 42, 50 to 52, 55 and 59 stand rejected as obvious. Claims 3, 4, 6 to 8, 10 to 16, 20, 21, 23 to 25, 27 to 33, 36, 37, 39 to 41, 43 to 49, 53, 54, 56 to 58, and 60 to 66 stand objected to for being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Responsibility for the above application has been transferred to the undersigned Attorney. <u>Please direct all further correspondence to the undersigned attorney.</u> A Revocation of Attorney and Appointment of New Attorney is being submitted under separate cover.

Applicants have amended the description to properly reflect the status of the application cited as a Related Application. Applicants have also amended the application to show that a continuing application based on the instant application has been filed.

Applicants note that no § 112 rejections have been given and so in the Examiner's opinion the claims comply with the requirements of § 112. Nevertheless, upon review of the claims, Applicants noted several antecedent basis informalities. Applicants amended Claims 3, 4, 6, 7, 8, 12 to 16, 20, 21, 23 to 25, 29 to 33, 36, 37, 39 to 41, 45 to 49, 53, 54, 56 to 58, and 62 to 66 to correct these informalities. Since the amendments correct informalities and no substantive §112 rejections were given, Applicants respectfully submit that the amendments do not affect the patentability of the claims.

Claim 1 stands provisionally rejected under 35 U.S.C. §
101 as claiming the same invention as that of Claim 1 of
copending U.S. Patent Application Serial No. 09/948,392.
Applicants will cancel Claim 1 in U.S. Patent Application
Serial No. 09/948,392. Accordingly, this rejection is rendered
moot. Applicants respectfully request reconsideration and
withdrawal of the §101 same invention rejection.

Claims 1, 17, 34 and 50 stand provisionally rejected under
the judicially created doctrine of obviousness-type double
patenting as being unpatentable over Claims 67, 83, 100 and 111
of copending U.S. Patent Application Serial No. 09/948,392.
The Examiner stated in part "the only different [Sic] between
the instant application and the copending application is the
instant application claims a method for dynamic implementation
of Java Metadata Interface to a metamodel while the copending
application claims an apparatus for dynamic implementation of
Java Metadata Interface to a metamodel." (Emphasis in
original.)

Applicants respectfully traverse the provisional
obviousness-type double patenting rejection. The Examiner
rationale goes against the common practice of issuing
restriction requirements between method and apparatus claims.
Following the Examiner's rationale, every restriction
requirement would be improper because the resulting application
would be subject to an obviousness-type double patenting
rejection because one was directed to a method and the other to
an apparatus. This is clearly not the case as evidenced by the
Patent Office practice.

Applicants respectfully submit that to support this
rejection, the Examiner must show that restriction would not
have been proper in the instant application. According to the
MPEP:

Process and apparatus for its practice can be shown to
be distinct inventions, if either or both of the following

can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus . . . (MPEP §806.05(e))

The rejection fails to establish that the processes of Claims 1 and 17 in the instant application cannot be practiced by another materially different apparatus from that recited in Claims 100 and 111 in the child application, for example. Thus, Applicants respectfully submit that a proper basis for the obviousness type double-patenting rejection has not been established for these claims. Similarly, Claims 34 and 50 are directed to a computer program product. Applicants respectfully request reconsideration and withdrawal of the obviousness-type double patenting rejection.

Finally, Applicants note that the equivalent rejection has been given in the copending application. Applicants respectfully submit that the rejection is proper in only one of the two applications. Both should not be subject to a terminal disclaimer. For example, if the instant application had issued prior to the obvious-type double patenting rejection, the obviousness-type double patenting rejection would only be given in the later pending application. Since it is unknown whether either application will issue and which will be the first to issue, Applicants respectfully submit that even though the rejection is provisional, it is premature. If the obviousness-type double patenting rejection is not withdrawn, Applicants request in the alternative that the rejection be suspended until a notice of allowance is issued in one of the applications. At that time, the rejection can be reinstated in the other of the applications.

Claims 1, 17, 18, 34, 50 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Admitted Prior Art in view of "Dynamic Proxy Classes" of Sun Microsystems, Inc. The Examiner stated in part:

11. . . . Sun teaches a dynamic proxy class that implements a list of interfaces specified at runtime when the class is created (page 1).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of the APA and Sun because it will improve the performance of APA' system because it does not required [Sic] pre-generation of the proxy class, such as with compile-time tools.

Applicants respectfully traverse the obviousness rejection of Claim 1. Applicants note that the MPEP requires:

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art."

MPEP § 2143.03, Eighth Edition, Rev. 2, P. 2100-133 (May, 2004)

The rejection as noted above demonstrates that all words in Claim 1 were not considered. In particular, Claim 1 recites in part:

receiving a JMI implementation request, said request associated with a metamodel, said metamodel comprising at least one package, said at least one package comprising at least one class, said at least one class comprising at least one attribute, reference or operation; implementing a package proxy JMI interface when said request comprises a package proxy request; implementing a class proxy JMI interface when said request comprises a class proxy request; and implementing a class instance JMI interface when said request comprises a class instance request. (Emphasis added.)

The rejection has cited no teaching or suggestion of dynamically implementing the first and last operations, of dynamically varying the implementing operations based upon the JMI implementation request received, or of the combination of the four operations with the recited functionality of each, as recited in Claim 1. At best, the rejection addresses only a portion of some of the recited limitations associated with proxies, and this assumes arguendo that the combination of references is correct. Applicants respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Applicants respectfully traverse the rejection of Claim 17. The above comments and quotation from the MPEP are incorporated herein by reference. Moreover, in an obviousness rejection, the Examiner is required to consider inherent properties as disclosed in the specification.

DISCLOSED INHERENT PROPERTIES ARE PART OF "AS A WHOLE" INQUIRY

"In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification.

MPEP § 2141.02, Eighth Edition, Rev. 2, P. 2100-126 (May, 2004)

Claim 17 recites in part:

receiving a JMI implementation request, said request associated with a metamodel, said metamodel comprising at least one package, said at least one package comprising at least one class, said at least one class comprising at least one attribute, reference or operation;
implementing a JMI interface when said JMI interface is unimplemented; and

executing a stored JMI interface implementation when said JMI interface is implemented.

The secondary reference relied upon by the Examiner teaches at most operations for a specific proxy class and fails to teach or suggest "means for implementing a JMI interface" or "means for executing a stored JMI interface," when the inherent properties of the JMI interface and the metamodel are considered as recited in the claim, e.g., "at least one class comprising at least one attribute, reference or operation." Each of the other means includes these class instances. Accordingly, the combination fails to teach every Claim limitation. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 17.

Claim 18 depends from Claim 17 and so distinguishes over the combination of references for at least the same reasons as Claim 17 given above, and incorporated herein by reference. In addition, the comments with respect to Claim 1 are also applicable to Claim 18 and are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 18.

Applicants respectfully traverse the obviousness rejection of Claim 34. Applicants note that no computer program product has been cited by the Examiner. In addition, the above remarks concerning Claim 1 and the prior art are applicable to Claim 34 and are incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of Claim 34.

Applicants respectfully traverse the obviousness rejections of Claims 50 and 51. Again, Applicants note that no computer program product has been cited by the Examiner. In addition, the above remarks concerning Claim 17 and the prior art are applicable to Claim 50 and are incorporated herein by reference. Similarly, the above remarks concerning Claim 18 and the prior art are applicable to Claim 51 and are

incorporated herein by reference. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 50 and 51.

Claims 2, 5, 9, 19, 22, 26, 35, 38, 42, 52, 55, and 59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Admitted Prior Art in view of "Dynamic Proxy Classes" of Sun Microsystems, Inc., and further in view of U.S. Patent No. 6,385,661 B1, hereinafter Guthrie.

Applicants note that the information cited in Guthrie does not overcome the basic deficiencies in the primary combination noted above. Accordingly, each of Claims 2, 5, 9, 19, 22, 26, 35, 38, 42, 52, 55, and 59 distinguish over the combination of references for at least the same reason as the independent claim upon which they depend. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 2, 5, 9, 19, 22, 26, 35, 38, 42, 52, 55, and 59.
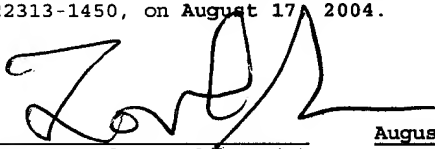
Applicants note that the Examiner indicated that Claims 3, 4, 6 to 8, 10 to 16, 20, 21, 23 to 25, 27 to 33, 36, 37, 39 to 41, 43 to 49, 53, 54, 56 to 58, and 60 to 66 recite patentable subject matter. However, in view of the patentability of the independent Claims, Applicants have not amended these claims at this time to include the limitations of the claims upon which they depend.

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Claims 1 to 66 remain in the application. Claims 3, 4, 6, 7, 8, 12, 13 to 16, 20, 21, 23 to 25, 29 to 33, 36, 37, 39 to 41, 45 to 49, 53, 54, 56 to 58, and 62 to 66 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 17, 2004.

_____ **August 17, 2004**
Attorney for Applicant(s)   Date of Signature

Respectfully submitted,

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